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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,486	04/25/2001	Yasuo Iwasa	Q63961	4521

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EXAMINER	
VO. HAI	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/841,486

Applicant(s)

IWASA ET AL.

Examiner

Hai Vo

Art Unit

1771

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION.** See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 21 August 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☒ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the _____ application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.


Claim(s) objected to: _____.

Claim(s) rejected: 1-19.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: The phrase "consisting essentially of" in the claim simply means that the porous resin film can include additional components which do not materially affect the novel characteristics of Applicant's invention (See MPEP 2112). Since there is no declaration or evidence in the specification to demonstrate that the presence of the surface active agent, a polyhydric alcohol, a water-miscible organic solvent as argued by Applicant would materially change the novel characteristics of Applicant's invention, the amendments do not place the application in condition for allowance. Further, the arguments that Suzuki does not meet the amount of the hydrophilic thermoplastic resin are not found persuasive. Claim 1 is unspecific about the nature of the hydrophilic thermoplastic resin and Suzuki teaches the amount of the hydrophilic thermoplastic resin within the claimed range (column 5, lines 29-33). The examiner respectfully points out that the polyethylene glycol listed in example 2 of Suzuki is not relied on as the claimed hydrophilic thermoplastic resin as argued by Applicant, therefore the arguments related to the contact angle with water is invalid and irrelevant. In addition, Applicant argues that the hydrophilic solid power of Suzuki do not substantially melt at the melting temperature of the kneaded thermoplastic resin or that Suzuki fails to disclose the kneading in an intermeshing twinscrew extruder at the screw shear rate of 100 sec-1 or higher. However, they are the process-by-product limitations which do not show the structural difference of the claimed product over the prior art. The examiner maintains that the liquid absorption property is an inherent property because the composition for obtaining the film of Suzuki is the same as in the presently claimed invention. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. The micrographs shows that differences in the expansion ratio would lead to differences in degree of stretching of the porous film are not found persuasive because nothing about the expansion ratio has been included in the claims. Applicant should provide evidence or declaration to show how the expansion ratio and the liquid absorbing capability are related to each other and Suzuki could not inherently possess the recited liquid absorbing property based on the disclosed expansion ratio to overcome the finding of obviousness and place the instant claims in condition for allowance.


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